

canceled. No new matter has been added. Upon entry of this amendment, claims 21, 41, 42, 44-49 are pending.

### ***Specification***

The specification has been amended to state that the formation of the upper occurs throughout a series of separate operations *at several workstations*. This phrase is supported by the application as filed, since the italicized was previously deleted in the October 8, 2002 amendment.

### ***Telephone Interview With Examiner Lee***

Applicants express their appreciation to Examiner Lee for the telephone interview that took place on March 3, 2003. In the interview, Applicants' attorney and Examiner Lee discussed the rejection of pending claim 21 in the January 2, 2003 Office Action and proposed additional amendments to claim 21. In particular, we discussed amending claim 21 to reflect that the apparatus include several workstations for forming the upper. The substance of the interview is discussed in more detail below. Examiner Lee generally agreed to the proposed claim amendment but asked that Applicants file a Request for Continued Examination (RCE).

### ***Claim Rejections – 35 U.S.C. § 102(b)***

Claim 21 is rejected as being anticipated by U.S. Patent No. 2,878,523 ("Hardy"). As discussed, this rejection is traversed.

Claim 21 is directed to a method of making an item of footwear and has been amended to further comprise the steps of, *inter alia*, providing an apparatus having a plurality of separate workstations for performing discrete fabrication operations on the upper, including a moulding workstation for moulding a rubber sole, and moving the last with the formed upper thereon sequentially through the plurality of separate workstations to the moulding workstation.

As discussed, the apparatus disclosed in Hardy relates to "string-lasting" of a shoe upper (11) to a last (L). As shown in Fig. 2 and 3, the upper is first prepared in conventional fashion by stitching the vamp (15) and quarters (17) to provide a circular upper assembly. (Col. 5, lines 52-

57) A drawstring (23) is then placed on the upper along the edge of the margin as shown in Fig. 3. The upper with the drawstring incorporated at its edge is then placed on a metal last (L) and its lasting margin is drawn snugly in over the bottom of the last by tightening the drawstring as shown in Fig. 6. (Col. 5, lines 70-73) Therefore, in Hardy, the upper is already formed before it is placed on the last. The technique described in Hardy does not require *a plurality of separate workstations for performing discrete fabrication operations on the upper* and does not move the last with the formed upper thereon *sequentially through the plurality of separate workstations* as now claimed in claim 21.

Furthermore, claim 21 has been amended to include the step of removably mounting the forming last with the formed upper thereon on the apparatus.

As discussed, in Hardy, once the upper is mounted on the last, the apparatus then rotates the upper and the last to the mold cavity 29. Therefore, as discussed, in the apparatus disclosed in Hardy, the last is permanently mounted to the moulding apparatus. The technique described in Hardy does not involve *removably mounting the forming last with the formed upper thereon* on the apparatus.

Accordingly, the rejection of claim 21 should be withdrawn.

#### ***Claim Rejections – 35 U.S.C. § 103(a)***

Claims 22-23 and 41-49 are rejected as being unpatentable over U.S. Patent No. 2,878,523 (“Hardy”), as applied in claim 21 in further view of U.S. Patent No. 5,955,017 (“Foffano et al.”). Claims 22, 23, and 43 have been canceled. Without acceding to the propriety of the rejection, claims 41, 42, 44-49 depend on claim 21, and are patentable for at least the same reasons as claim 21, as discussed above.

#### ***Conclusion***

The Applicant has amended the specification for clarity. In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the

application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to deposit account No. 23/2825.

Respectfully submitted,

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**MARKED-UP SPECIFICATION**

On page 9, starting at line 20 please rewrite the paragraph as follows.

The formation or manufacture of an upper (3) for an item of footwear typically involves cutting, shaping, and stitching of a flexible material, such as real or imitation leather, around the body (8) of the forming last (5). The formation of the upper (3) takes place predominantly at room temperature and occurs throughout a series of separate operations at several workstations. Once the shoe upper (3) is completed, the last (5) with the formed upper thereon, is mounted on the apparatus (1) and is moved to a workstation (20) specifically designed for injection moulding of a rubber sole (4) onto the upper.

**MARKED-UP CLAIMS**

21. (Twice Amended) A method of making an item of footwear, the method comprising the steps of:

forming an upper for the item of footwear on a forming last, the forming last including a body having the general shape of a foot around which the upper of the footwear item is formed in a series of separate operations, the last body having a base corresponding to a sole of the foot shape;

providing an apparatus having a plurality of separate workstations for performing discrete fabrication operations on the upper, and including a moulding workstation for moulding a rubber sole;

removably mounting the forming last with the formed upper thereon on [an] the apparatus [for moulding a rubber sole];

moving the last with the formed upper thereon sequentially through the plurality of separate workstations to [a] the moulding workstation [of the apparatus]; and

moulding a rubber sole onto the formed upper while it is still mounted on the forming last, the forming last being heated before and/or during the moulding step, wherein the step of heating the forming last includes heating the base of the last body, whilst substantially preventing the heating of parts of the body other than the base.